

S/N 09/824,937

PATENT

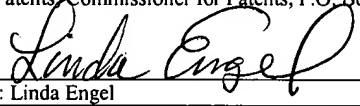
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	GREINER	Examiner:	S. Castellano
Serial No.:	09/824,937	Group Art Unit:	3727
Filed:	April 3, 2001	Docket No.:	13345.36US01
Title:	DECORATIVE CONTAINER		
Customer No.	23552		

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CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 14, 2004.

By:   
Name: Linda Engel

**APPELLANT'S BRIEF ON APPEAL**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Brief is presented in support of the Notice of Appeal filed July 14, 2004, from the final rejection of claims 15-19 and 21-33 of the above-identified application, as set forth in the Office Action mailed April 14, 2004. To simplify matters for appeal, however, claims 27-33 were canceled by Amendment filed concurrent with this Appeal Brief.

A check for \$170.00 to cover the required fee for filing this Brief is enclosed. If an additional fee is required, please charge Deposit Account No. 13-2725. Applicant hereby requests an oral hearing. A request for an oral hearing under 37 C.F.R. § 1.194 will be submitted along with the fee within two months of the Examiner's Answer.

# **I. REAL PARTY OF INTEREST**

The Real Party of Interest is Lori Greiner, an individual.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal for the above-referenced patent application.

### **III. STATUS OF CLAIMS**

After entry of the Amendment filed herewith, claims 15-19 and 21-26 are pending. Claim 15 is the only independent claim.

All of the pending claim are rejected. Claims 15-18, 21-23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,553,735 (Kimura) in view of U.S. Patent No. 5,674,546 (Barnes) and U.S. Patent No. 2,802,590 (Tupper). Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura in view of Barnes, Tupper, and U.S. Patent No. 3,992,811 (Yellin). Claims 15-18, 21, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,275,277 (Gallegos) in view of Barnes and Tupper. Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallegos in view of Barnes, Tupper, and Yellin.

Rejected claims 15-19 and 21-26, which are the entirety of the pending claims after the entry of the Amendment, are the subject of this Appeal and are presented in the Claims Appendix.

Below is a summary of the status of all claims in the proceeding after the entry of the Amendment.

1-14.	Canceled
15-19.	Rejected
20.	Canceled
21-26.	Rejected
27-33.	Canceled.

#### **IV. STATUS OF AMENDMENTS AFTER FINAL REJECTION**

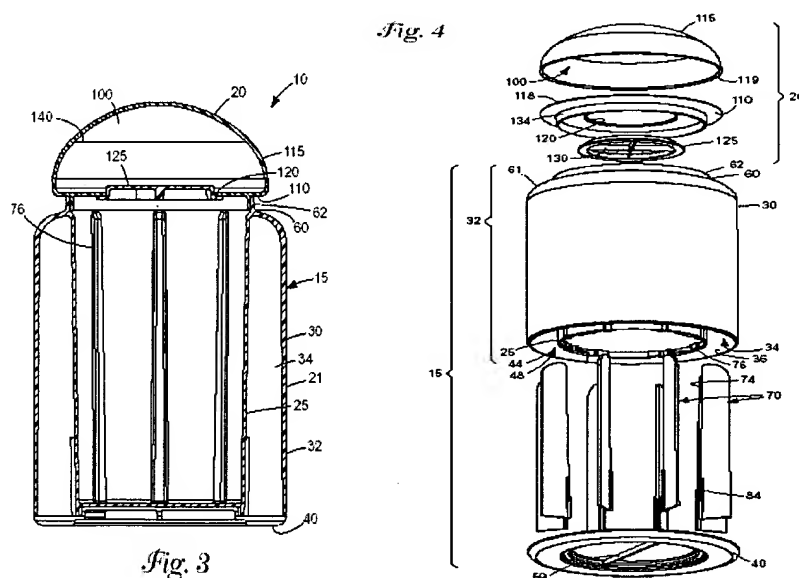
A final Office Action in this case was mailed on April 14, 2004. An Amendment canceling claims 27-33 is filed herewith. The Examiner indicated, in a telephone message delivered on or about August 30, 2004 to Appellant's counsel, that such an Amendment would be entered. No other amendment was filed after the April 14, 2004 Office Action.

## V. SUMMARY OF THE CLAIMED SUBJECT MATTER

A summary of the claimed invention follows. The summary includes references to an embodiment disclosed in the specification.

Independent claim 15 is directed to a decorative container system for displaying items in a hollow region.<sup>1</sup> See FIGS. 3 and 4 (reproduced below in Illustration A) for one example of a decorative container system according to claim 15. The system includes a decorative container 15 with an upper opening (defined by neck 62) and an inner container 25 positioned within an outer container 30 thereby defining the hollow region 34 therebetween. *Id.* The outer container 30 is at least partially transparent.<sup>2</sup> A removable hollow region access member 40 allows access to the hollow region 34.<sup>3</sup> A decorative lid 20 is shaped to be removably mounted in the upper opening of the decorative container 15.<sup>4</sup> The decorative lid 20 defines a hollow lid cavity 100 and is at least partially transparent. *Id.* The lid 20 further includes a removable lid access member 125 that provides access to the hollow lid cavity 100.<sup>5</sup> The removable lid access member 125 is replaceable in the decorative lid 20. *Id.*

### Illustration A: FIGS. 3 and 4 of the Application



<sup>1</sup> page 5, line 9 through page 6, line 4 of the specification

<sup>2</sup> See page 5, line 27 through page 6, line 1

<sup>3</sup> See page 6, lines 5-9

<sup>4</sup> See page 5, line 4-5

<sup>5</sup> See page 10, lines 6-11 and FIGS. 3 and 4

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 15-18, 21-23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,553,735 (Kimura) in view of U.S. Patent No. 5,674,546 (Barnes) and U.S. Patent No. 2,802,590 (Tupper). Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura in view of Barnes, Tupper, and U.S. Patent No. 3,992,811 (Yellin). Claims 15-18, 21, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,275,277 (Gallegos) in view of Barnes and Tupper. Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallegos in view of Barnes, Tupper, and Yellin.

The issues presented for review:

- A. Whether claim 15 is patentable over Kimura in view of Barnes and Tupper.
- B. Whether claim 15 is patentable over Gallegos in view of Barnes and Tupper.

## **VII. ARGUMENT**

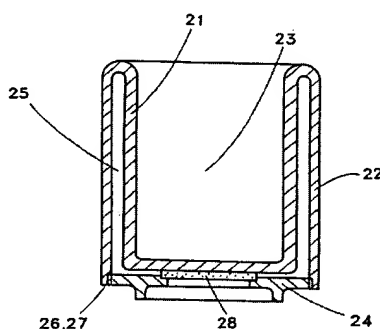
### **A. Claim 15 is Patentable over Kimura in View of Barnes and Tupper**

Claims 15-18, 21-23, and 26 were rejected as being unpatentable over U.S. Patent No. 5,553,735 to Kimura ("Kimura") in view of U.S. Patent No. 5,674,546 to Barnes et al. ("Barnes") and U.S. Patent No. 2,802,590 to Tupper ("Tupper").

Claim 15 teaches a decorative container system. The system includes a decorative container with an upper opening and an inner container positioned within an outer container thereby defining the hollow region therebetween. A decorative lid is shaped to be removably mounted in the upper opening of the decorative container. The decorative lid defines a hollow lid cavity and is at least partially transparent. The lid further includes a removable lid access member that provides access to the hollow lid cavity. The removable lid access member is replaceable in the decorative lid.

Kimura relates to a drinking vessel for holding a liquid including an outer shell and an inner shell, forming a cavity between the two shells.

#### **Illustration B: FIG. 4 of Kimura**

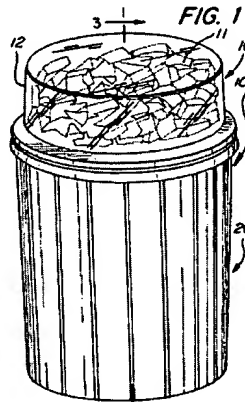


As acknowledged by the Examiner, Kimura does not show a decorative lid of any type, and further does not show a decorative lid with a removable and replaceable lid access member. To remedy this deficiency, the Examiner asserts that Barnes and Tupper teach the decorative lid of the present invention. However, Barnes and Tupper fall far short in teaching the decorative lid of the present invention.



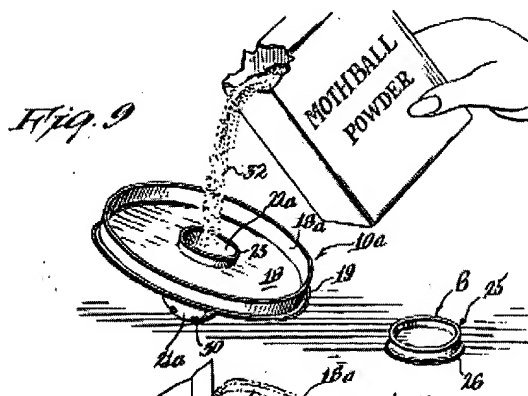
Barnes discloses a package for selling omelet ingredients that can also be used for cooking the omelet in a microwave oven. As shown in Figure 1 below, an upper container 10 overlies a lower container 20. The upper container 10 holds omelet inlay material 11 (e.g., vegetables), and the lower container 20 holds a packaged liquid egg product and functions as the cooking vessel for the omelet. The omelet inlayer material 11 is preferably held in the upper container 10 by the use of a sealing foil. *See, e.g., Barnes, col 5, lines 39-67.*

**Illustration C: FIG. 1 of Barnes**



Tupper discloses a waste can with a cover that has a region for receiving deodorant tablets or powder. The cover is provided with a chamber 22a for holding deodorizers, such as moth balls or disinfecting powders, and a bottom chamber cover B. A top part of the cover has perforations 30 to allow fumes to escape to the area surrounding the waste can. *See, e.g., Tupper column 5, lines 19-46.*

**Illustration D: FIG. 9 of Tupper**



The Examiner argues that the upper container 10 of Barnes that holds omelet filling ingredients teaches a decorative lid, and argues that it would have been obvious to add the upper container 10 of Barnes to the container of Kimura. The Examiner further argues that it would be obvious to combine the cover for the waste can shown in Tupper with the upper container 10 of Barnes to obtain a removable and replaceable lid access member for the upper container 10 of Barnes.

Applicant believes that the Examiner's reasoning is incorrect. First, the references are non-analogous and it would not be obvious to one of skill in the art to combine them. Second, there is no motivation found in the prior art for combining the drinking glass of Kimura with the upper container having a cavity for omelet ingredients of Barnes and the waste can of Tupper.

### 1. The Non-analogous References: Drinking Glass, Omelet Package, and Waste Can

This combination would not be obvious to one of skill in the art because the vessel of Kimura is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The Kimura drinking vessel is preferably made of plastic injection molded material, and is washable and reusable. (See Kimura, Col. 2, lines 43-47.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials like paperboard, paperboard-polymer laminates, foamed plastic, or polystyrene that are not suited for washing and reuse. (See Barnes, Col. 6, lines 11-24.) The upper container **10** of Barnes is clearly designed for one-time use as it is closed with a sealing foil **16** that is adhered to the upper sealing flange of

the upper container 10 with an adhesive releasable seal. Because Kimura describes a washable drinking glass while Barnes describes a disposable microwave-cooking container for one-time use, it would not be obvious to combine Kimura and Barnes. One of skill in the art developing a reusable drinking glass would not turn to the field of disposable food packaging and microwave cooking containers for convenience foods.

Moreover, the combination of Tupper with either Kimura or Barnes would not be obvious to one of ordinary skill in the art. Tupper is not directed to a decorative container system as claimed, or a drinking glass as described in Kimura but rather to a waste can with a means of deodorizing the odors present in the waste can. Tupper's deodorized waste can and Barnes' one-time use omelet cooker are so different and serve such different purposes that one of ordinary skill in the art would not seek to combine these references. *See, e.g., In re Clay*, 966 F.2d 656, 659-60, 23 U.S.P.Q.2d 1058, 1961 (Fed. Cir. 1992) ("If [a reference] is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.").

## 2. No Motivation to Combine References to Provide a Lid with a Cavity

In addition, there is no motivation to combine the references found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the vessel of Kimura in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking vessels to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel.

As for Barnes, the upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has presented no motivation found in the prior art for modifying the drinking vessel of Kimura to add an upper container with a cavity.

Tupper does not remedy this deficiency. Tupper discloses a cover for a waste can with a capacity to hold a deodorizer. There would be no reason to provide a holding capacity in the lid of a drinking vessel, and especially not for a deodorizing element as provided in the waste can of

Tupper. Accordingly, there would be no reason to combine Kimura with Tupper to provide a drinking vessel with an upper container having a cavity.

The mere fact that the prior art could be modified in the manner proposed by the examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. *Ex parte Dussaud*, 7 USPQ2d 1818, 1820 (BPAI 1988). In *Dussaud*, the Examiner argued that a first reference teaching a single roller for manufacturing straight line elastic strips for a diaper could be modified by a second reference teaching a pair of rollers for manufacturing a curvilinear elastic strip to obtain a single roller structure capable of manufacturing curvilinear elastic strips. The Board of Patent Appeals and Interferences, however, found that the Examiner's modification was based on hindsight, and rejected the assertion that there was any motivation to combine the cited references. *Id.* at 7-8. Similarly, in the present application, there is no motivation to combine the cited references.

3. No Motivation to Combine References to Provide a Lid with a Replaceable Lid Access Member

The Examiner also asserts that it would be obvious to combine Barnes with Tupper to obtain a replaceable lid access member in order to "change the contents and store a refreshed supply of items in the hollow lid cavity." However, because Barnes is a one-time use omelet cooker, there would be no reason to modify it so that the lid is replaceable. The one-time use lid in Barnes is not intended to be reused as indicated by the materials described in Barnes. Therefore, there is also no motivation to combine Barnes with Tupper in the manner suggested by the Examiner.

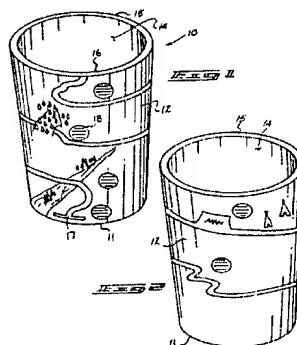
For these reasons, claim 15 is patentable over Gallegos in view of Barnes and Tupper. For at least the same reasons, dependent claims 16-19, and 21-26 are also believed to be in condition for allowance. A notice of allowance is respectfully requested.

**B. Rejections Over Gallegos In View of Barnes and Tupper**

Claims 15-18, 21, 22, and 26 were rejected as being unpatentable over U.S. Patent No. 5,275,277 to Gallegos ("Gallegos") in view of Barnes and Tupper. Applicant traverses this rejection.

Gallegos discloses a novelty drinking glass. The Office Action argues that Gallegos teaches the invention except for the decorative lid.

**Illustration E: FIGS. 1 and 2 of Gallegos**



The Examiner argues that it would have been obvious to modify Gallegos to add the upper container of Barnes and Tupper in order to "close the container and seal the contents from contamination." Applicant respectfully disagrees with this rejection. This rejection is not proper for the same reasons that the rejection over Kimura, Barnes, and Tupper is not proper:

1. The references are non-analogous and it would not be obvious to one of skill in the art to combine them.

2. There is no motivation found in the prior art for combining the drinking glass of Gallegos with the upper container having a cavity of Barnes.

3. There is no motivation to modify the upper container of the Barnes/Gallegos combination to have the replaceable lid access member of Tupper because Barnes is disposable.

1. The Non-analogous References: Drinking Glass, Omelet Package, and Waste Can

This combination would not be obvious to one of skill in the art because, similar to the drinking vessel of Kimura, the drinking glass of Gallegos is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more

convenient food to cook in the microwave. The Gallegos drinking glass is preferably reusable and of "durable and reliable construction." (*See* Gallegos, Col. 2, lines 35-37.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials, as discussed above. (*See* Barnes, Col. 6, lines 11-24.) Because Gallegos describes a durable, reusable drinking glass while Barnes describes a microwave-cooking container for one-time use, it would not be obvious to combine Gallegos and Barnes.

Moreover, the combination of Tupper with either Gallegos or Barnes would not be obvious to one of ordinary skill in the art. Tupper is not directed to a decorative container system as claimed, but rather to a waste can with a means of deodorizing the odors present in the waste can. Tupper's deodorized waste can and Barnes' one-time use omelet cooker are so different and serve such different purposes that one of ordinary skill in the art would not seek to combine these references. *See, e.g., In re Clay*, 966 F.2d 656, 659-60, 23 U.S.P.Q.2d 1058, 1961 (Fed. Cir. 1992) ("If [a reference] is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.").

## 2. No Motivation to Combine References to Provide a Lid with a Cavity

Tupper is directed to a waste can with a chamber to hold a deodorizer. There would not be any motivation to alter Gallegos so that the deodorizing chamber of Tupper is included in a lid to the drinking glass. Moreover, since waste cans are not generally disposable, there would not be any motivation for combining Tupper with the one-time use omelet-cooking container of Barnes.

In addition, there is no motivation to combine Gallegos, Barnes, and Tupper found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the glass of Gallegos in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking glasses to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel. The upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has not

presented any motivation found in the prior art for modifying the drinking glass of Gallegos to add the upper container of Barnes, as opposed to a conventional lid.

Tupper does not remedy this deficiency. Tupper discloses a cover for a waste can with a capacity to hold a deodorizer. There would be no reason to provide a holding capacity in the lid of a drinking vessel, and especially not for a deodorizing element as provided in the waste can of Tupper. Accordingly, there would be no reason to combine Gallegos with Tupper to provide a drinking vessel with an upper container having a cavity.

3. No Motivation to Combine References to Provide a Lid with a Replaceable Lid Access Member

The Examiner also asserts that it would be obvious to combine Barnes with Tupper to obtain a replaceable lid access member in order to "change the contents and store a refreshed supply of items in the hollow lid cavity." However, because Barnes is a one-time use omelet cooker, there would be no reason to modify it so that the lid is replaceable. The one-time use lid in Barnes is not intended to be reused. Therefore, there is no motivation to combine Barnes with Tupper in the manner suggested by the Examiner.

For these reasons, claim 15 is patentable over Gallegos in view of Barnes and Tupper. For at least the same reasons, dependent claims 16-19, and 21-26 are also believed to be in condition for allowance.


**C. Conclusion**

Applicant submits that the rejections should be withdrawn in view of the non-analogous nature of the references and the lack of motivation for combining the separate elements of the three references. A notice of allowance is respectfully requested.

Respectfully submitted,

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Date: October 14, 2004

  
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## **CLAIMS APPENDIX:**

### **Claims involved in the appeal**

15. A decorative container system for displaying items in a hollow region comprising:
- a decorative container comprising an upper opening and an inner container positioned within an outer container thereby defining the hollow region therebetween, wherein the outer container is at least partially transparent;
  - a removable hollow region access member allowing access to the hollow region; and
  - a decorative lid shaped to be removably mounted in the upper opening of the decorative container, the decorative lid defining a hollow lid cavity and being at least partially transparent, the lid further comprising a removable lid access member providing access to the hollow lid cavity, wherein the removable lid access member is replaceable in the decorative lid.
16. The decorative container system of claim 15 wherein the decorative lid further comprises a base portion and a shell that cooperates with the base portion to define the hollow lid cavity, wherein the base portion defines a lid access opening that provides access to the hollow lid cavity, wherein the removable lid access member is mounted in the lid access opening.
17. The decorative container system of claim 16, wherein the transparent shell is dome shaped.
18. The decorative container system of claim 16, wherein the distance between the shell and the base portion is at least about two centimeters at the point of greatest separation within the hollow lid cavity.
19. The decorative container system of claim 15, further comprising a plurality of dividers extending radially from the inner container to the outer container in the hollow region, the dividers being spaced about the hollow region defining a plurality of hollow cavities within the hollow region.

21. The decorative container system of claim 15 wherein the removable hollow region access member is configured to allow replacement into the decorative container system after removal.
22. The decorative container system of claim 15 wherein the decorative lid is replaceable in the upper opening.
23. The decorative container system of claim 15 wherein the removable hollow region access member is positioned at an end of the decorative container opposite to the upper opening.
24. The decorative container system of claim 19, wherein the dividers are removable from the hollow region.
25. The decorative container system of claim 24, wherein the dividers are configured to allow replacement within the hollow region after removal.
26. The decorative container system of claim 15, wherein the inner container is at least partially transparent.

## **EVIDENCE APPENDIX**

### **A. OFFICE ACTIONS AND AMENDMENTS/RESPONSES**

1. Amendment canceling claims 27-33 -- mailed concurrent with this Appeal Brief.

### **B. REFERENCES RELIED UPON BY THE EXAMINER**

Copies of these references are attached.

1. U.S. Patent No. 5,553,735 (Kimura)
2. U.S. Patent No. 5,674,546 (Barnes)
3. U.S. Patent No. 2,802,590 (Tupper)
4. U.S. Patent No. 3,992,811 (Yellin)
5. U.S. Patent No. 5,275,277 (Gallegos)

### **C. CASES CITED IN THE BRIEF**

Copies of these cases are attached.

*In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992)

*Ex parte Dussaud*, 7 USPQ2d 1818 (BPAI 1988)

## **RELATED PROCEEDINGS APPENDIX**

None.

LEXSEE 966 F2D 656

IN RE CARL D. CLAY

91-1402

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

*966 F.2d 656; 1992 U.S. App. LEXIS 13091; 23 U.S.P.Q.2D (BNA) 1058*

June 10, 1992, Decided

**PRIOR HISTORY:** **[\*\*1]** Appealed from: U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

**DISPOSITION:** REVERSED.

**LexisNexis(R) Headnotes**

**COUNSEL:** Jack E. Ebel, Marathon Oil Company, of Littleton, Colorado, argued for appellant. With him on the brief was Paul T. Meiklejohn, Seed & Berry, of Seattle, Washington, of counsel.

Teddy S. Gron, Associate Solicitor, Office of The Solicitor, of Arlington, Virginia, argued for appellee. With him on the brief was Fred E. McKelvey, Solicitor. Of counsel was Richard E. Schafer.

**JUDGES:** Before PLAGER, LOURIE, and CLEVINGER, Circuit Judges.

**OPINIONBY:** LOURIE

**OPINION:** **[\*657]**

LOURIE, Circuit Judge.

Carl D. Clay appeals the decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences, Appeal No. 90-2262, affirming the rejection of claims 1-11 and 13 as being unpatentable under 35 U.S.C. § 103. These are all the remaining claims in application Serial No. 245,083, filed April 28, 1987, entitled "Storage of a Refined Liquid Hydrocarbon Product." We reverse.

**BACKGROUND**

Clay's invention, assigned to Marathon Oil Company, is a process for storing refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port. The process involves preparing a **[\*\*2]** gelation solution which gels after it is placed in the tank's dead volume; the gel can easily be removed by adding to the tank a gel-degrading agent such as hydrogen peroxide. Claims 1, 8, and 11 are illustrative of the claims on appeal:

1. A process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the bottom of said tank and an outlet port in said tank, said process comprising:

preparing a gelation solution comprising an aqueous liquid solvent, an acrylamide polymer and a crosslinking agent containing a polyvalent metal cation selected from the group consisting of aluminum, chromium and mixtures thereof, said gelation solution capable of forming a rigid crosslinked polymer gel which is **[\*658]** substantially insoluble and inert in said refined liquid hydrocarbon product;

placing said solution in said dead volume;

gelling said solution substantially to completion in said dead volume to produce said rigid gel which substantially fills said dead volume; and

storing said refined liquid hydrocarbon product in said storage tank in contact with said gel without substantially contaminating said product with said gel and without substantially degrading **[\*\*3]** said gel.

8. The process of claim 1 further comprising removing said rigid gel from said dead volume by contacting said gel with a chemical agent which substantially degrades said gel to a flowing solution.

11. The process of claim 1 wherein said gelation solution further comprises an aqueous liquid contaminant present in said dead volume which dissolves in said solution when said solution is placed in said dead volume.

Two prior art references were applied against the claims on appeal. They were U.S. Patent 4,664,294 (Hetherington), which discloses an apparatus for displacing dead space liquid using impervious bladders, or large bags, formed with flexible membranes; and U.S. Patent 4,683,949 (Sydansk), also assigned to Clay's assignee, Marathon Oil Company, which discloses a process for reducing the permeability of hydrocarbon-bearing formations and thus improving oil production, using a gel similar to that in Clay's invention.

The Board agreed with the examiner that, although neither reference alone describes Clay's invention, Hetherington and Sydansk combined support a conclusion of obviousness. It held that one skilled in the art would glean from Hetherington that Clay's invention [\*\*4] "was appreciated in the prior art and solutions to that problem generally involved filling the dead space with something." Opinion at 3 (emphasis in original).

The Board also held that Sydansk would have provided one skilled in the art with information that a gelation system would have been impervious to hydrocarbons once the system gelled. The Board combined the references, finding that the "cavities" filled by Sydansk are sufficiently similar to the "volume or void space" being filled by Hetherington for one of ordinary skill to have recognized the applicability of the gel to Hetherington.

#### DISCUSSION

The issue presented in this appeal is whether the Board's conclusion was correct that Clay's invention would have been obvious from the combined teachings of Hetherington and Sydansk. Although this conclusion is one of law, such determinations are made against a background of several factual inquiries, one of which is the scope and content of the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

A prerequisite to making this finding is determining what is "prior art," in order to consider whether "the differences between [\*\*5] the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. Although § 103 does not, by its terms, define the "art to which [the] subject matter [sought to be patented] pertains," this determination is frequently couched in terms of whether the art is analogous or not, i.e., whether the art is "too remote to be

treated as prior art." *In re Sovish*, 769 F.2d 738, 741, 226 USPQ 771, 773 (Fed. Cir. 1985).

Clay argues that the claims at issue were improperly rejected over Hetherington and Sydansk, because Sydansk is nonanalogous art. Whether a reference in the prior art is "analogous" is a fact question. *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n.9, 1 USPQ2d 1593, 1597 n.9 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Thus, we review the Board's decision on this point under the clearly erroneous standard.

Two criteria have evolved for determining whether prior art is analogous: (1) [\*\*6] whether the art is from the same field [\*\*6] of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

The Board found Sydansk to be within the field of Clay's endeavor because, as the Examiner stated, "one of ordinary skill in the art would certainly glean from [Sydansk] that the rigid gel as taught therein would have a number of applications within the manipulation of the storage and processing of hydrocarbon liquids . . . [and that] the gel as taught in Sydansk would be expected to function in a similar manner as the bladders in the Hetherington patent." These findings are clearly erroneous.

The PTO argues that Sydansk and Clay's inventions are part of a common endeavor -- "maximizing withdrawal of petroleum stored in petroleum reservoirs." However, Sydansk cannot be considered to be within Clay's field of endeavor merely because both relate to the [\*\*7] petroleum industry. Sydansk teaches the use of a gel in unconfined and irregular volumes within generally underground natural oil-bearing formations to channel flow in a desired direction; Clay teaches the introduction of gel to the confined dead volume of a man-made storage tank. The Sydansk process operates in extreme conditions, with petroleum formation temperatures as high as 115degreeC and at significant well bore pressures; Clay's process apparently operates at ambient temperature and atmospheric pressure. Clay's field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of Sydansk's invention, on the other hand, is the extraction of crude petroleum. The Board clearly erred in considering Sydansk to be within the same field of endeavor as Clay's.

Even though the art disclosed in Sydansk is not within Clay's field of endeavor, the reference may still properly be combined with Hetherington if it is

reasonably pertinent to the problem Clay attempts to solve. *In re Wood*, 599 F.2d at 1036, 202 USPQ at 174. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's [\*\*8] endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

Sydansk's gel treatment of underground formations functions to fill anomalies n1 so as to improve flow profiles and sweep efficiencies of injection and production fluids through a formation, while Clay's gel functions to displace liquid product from the dead volume of a storage tank. Sydansk is concerned with plugging formation anomalies so that fluid is subsequently diverted by the gel into the formation matrix, thereby forcing bypassed [\*\*9] oil contained in the matrix toward a production well. Sydansk is faced with the problem of recovering oil from rock, i.e., from a matrix which is porous, permeable sedimentary rock of a subterranean formation where water has channeled through formation anomalies and bypassed oil present in the matrix. Such a problem is not reasonably pertinent to the particular problem with which Clay was involved -- preventing loss of stored [\*\*660] product to tank dead

volume while preventing contamination of such product. Moreover, the subterranean formation of Sydansk is not structurally similar to, does not operate under the same temperature and pressure as, and does not function like Clay's storage tanks. See *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) ("the similarities and differences in structure and function of the invention disclosed in the references . . . carry far greater weight [in determining analogy]").

n1 Sydansk refers to an anomaly, one of two general region types in an oil-bearing geological formation, as "a volume or void space [e.g., 'streaks, fractures, fracture networks, vugs, solution channels, caverns, washouts, cavities, etc.'] in the formation having very high permeability relative to the matrix [the other region type, consisting of homogeneous porous rock]."

#### [\*\*10]

A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies. The Board's finding to the contrary is clearly erroneous. Since Sydansk is non-analogous art, the rejection over Hetherington in view of Sydansk cannot be sustained.

#### CONCLUSION

For the foregoing reasons, the decision of the Board is REVERSED.

LEXSEE 7 USPQ2D 1818

Ex parte Jacques Dussaud and Raphael De Jonckheere

Appeal No. 666-06 from Art Unit 131.

Application for Patent filed May 1, 1984, Serial No. 605,970, which is a Continuation of Serial No. 301,262, filed September 11, 1981, now abandoned.

Process for Manufacturing Disposable Diapers And Diaper Briefs, And Disposable Diapers And Diaper Briefs Obtained By Application Of This Process.

Board of Patent Appeals and Interferences

*1988 Pat. App. LEXIS 11; 7 U.S.P.Q.2D (BNA) 1818*

April 5, 1988, Heard  
June 9, 1988, Decided

[\*1]

Before Milestone, Winters and Skinner, Examiners-in-Chief.

**COUNSEL:**

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Primary Examiner - Jerome Massie

**OPINIONBY: WINTERS**

**OPINION:**

Winters, Examiner-in-Chief.

Appeal from the examiner's decision refusing to allow claims 10 through 18 and 21, which are all the claims remaining in this application.

Claim 10 is representative:

10. A method of continuously attaching an elongated narrow elastic element to a moving flexible sheet material to be employed as an outer moisture impermeable envelope for receiving an absorbent pad of a disposable diaper, said elastic element fitting in a stretched condition substantially along a curvilinear-shaped-cut-out of said envelope to allow a leg therethrough when said envelope is constructed as a diaper, said method comprising the steps of:

- (a) passing an elongated narrow elastic element, along a longitudinal path of travel, in a stretched condition;
- (b) intermittently depositing liquid adhesive material at high temperature on said elastic element during said passing step (a);



(c) passing said elastic element, with adhesive material thereon, [\*2] over a fixed guide means;

(d) passing said elastic element with adhesive material over a carriage means, arranged down-stream of the fixed guide means in the direction of travel, and capable of being moved intermittently in a transverse direction;

(e) feeding said flexible sheet around the peripheral surface of a rotary drum such that the sheet remains in contact with said drum for about one-half the rotation of said drum, said drum having a smooth outer surface which is maintained at a substantially constant temperature, said temperature being less than the temperature of said liquid adhesive, the difference between the temperature of the adhesive at the time of contact with said flexible sheet and the temperature of said peripheral surface of the drum being at least 20 degrees C; and

(f) positioning said movable carriage immediately next to the periphery of said rotary drum at a location such that said carriage means and said drum are not in contact with each other and such that the adhesive coated elastic element contacts said flexible sheet supported by said drum, and said sheet together with said elastic element remain in contact with said drum for at least a portion of [\*3] the rotation of said rotary drum before leaving it, moving said carriage means intermittently in a direction transverse to the direction of rotation of said drum whereby said elastic element is laid-down on said drum in an oscillating path, and whereby said elastic element is intermittently attached in a stretched condition along a curved-shaped line only by laying said elastic element on said flexible sheet due to the temperature difference between the drum and the adhesive material;

and with the provision that steps (e) and (f) are conducted on a single drum and said temperature difference is sufficient to lead to an immediate adhesion effect capable of withstanding the transverse forces to which said elastic element is subjected owing to the movement of said carriage means.

The prior art references relied on by the examiner are:

Penman	3,150,023	Sep. 22, 1964
Bourgeois	3,828,367	Aug. 13, 1974
Buell	4,081,301	Mar. 28, 1978
Klasek et al. (Klasek)	4,293,367	Oct. 6, 1981
Teed	4,405,397	Sep. 20, 1983

Claims 10 through 16 and 21 stand rejected under 35 USC 103 as unpatentable over Klasek in view of the combined teachings of Buell, Penman, and Teed. Claims 17 [\*4] and 18 stand rejected under the same statutory provision as unpatentable over the same combination of references, further taken in view of Bourgeois.

#### OPINION

We shall not sustain these rejections.

Initially, we consider the question whether the Penman reference is from a nonanalogous art. First, we find it clear that this reference is not within the field of appellants' endeavor. On the contrary, Penman relates to the art of carpet manufacture whereas appellants' field of endeavor is the art of manufacturing disposable diapers. Indeed, each of the patents issued to Klasek, Buell, Teed, and Bourgeois relates to the art of making diapers, as does appellants' specification disclosure. Penman, which stands apart, relates to the art of making carpets.

Second, it is our judgment that Penman is not reasonably pertinent to the particular problem with which appellants were involved, i.e., the application of an elastic strip to a web in a curvilinear pattern. In determining this latter point, we have evaluated and weighed the Courtray declaration filed under Rule 132 wherein declarant sets forth reasons why the artisan "would not look to the carpet manufacturing process and [\*5] equipment field to solve a problem in the application of elastic to a web in a curvilinear pattern". See Paper No. 15, page 1. We note that the examiner entered and considered the declaration (see Paper Nos. 18 and 22) but found same "not persuasive" because, according to the examiner, declarant merely offers his opinion on the art of carpet making. The examiner discounted that opinion because declarant is not established as an expert in that art. We disagree with the examiner's analysis. The examiner does not deny that declarant is skilled in the art of manufacturing diapers, although declarant does not claim to have the same level of skill in the art of making carpets. In this regard, we note that persons having ordinary skill "could not possibly be aware of every teaching in every art". See *In re Wood*, 559 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979). Certainly, declarant expresses skepticism whether a person having ordinary skill in the art of manufacturing disposable diapers would consider the carpet manufacturing process and equipment field as reasonably pertinent to the particular problem with which the appellants were involved. As stated in *In re Dow Chemical Company*, 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988), skepticism expressed by an expert in the art is entitled to fair evidentiary weight.

We also find that the examiner's characterization of the problem in Paper No. 22, i.e., "the laminating of continuous running sheets utilizing a hot melt adhesive", is broader than the particular problem with which appellants were involved. Precise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the same token, defining the problem too broadly, as done here, may result in considering prior art as "analogous" which is inconsistent with real world considerations. See *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), aff'd on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Having applied the two-fold test for determining whether a reference is from a nonanalogous art, see *In re Wood*, supra, we hold that on the facts of this case the Penman reference constitutes nonanalogous art. It is therefore [\*7] not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103.

Turning to a consideration of the Teed patent of record, we find that Teed discloses a method for manufacturing disposable diapers wherein elastic strips are applied in a straight line. This is illustrated in Figure 8, note rectilinear elastic strips (16) therein. Klasek, on the other hand, discloses a method for manufacturing disposable diapers wherein the elastic strips are applied in a curvilinear profile, and Klasek requires that the web and elastic be secured together by a pair of juxtaposed rolls acting in concert. See particularly Klasek, Figures 4 and 9. Certainly, Klasek's method involving a pair of rolls could be modified per the disclosure of Teed which appears to illustrate the use of a single roller. In our view, however, such proposed modification amounts to a hindsight reconstruction of the prior art patents in order to arrive at appellants' invention. Without having the benefit of appellants' disclosure, the artisan would view Klasek's pair of rolls as serving an important function in facilitating the application of elastic strips in a curvilinear [\*8] profile. As discussed supra, the elastic strips in Teed are applied in a straight line and we disagree that the artisan would have found it obvious to substitute a single roller from Teed for a pair of rollers in Klasek, whose objective is to apply elastic strips in a curvilinear profile.

The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and cases cited therein. We have carefully reviewed the Klasek and Teed references in their entireties, and we find no express or implied suggestion in the collective teachings of these references which would have motivated the artisan to combine them in the manner proposed.

In conclusion, we hold that the Penman reference constitutes nonanalogous art and is therefore not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103. With respect to the Teed patent of record, we conclude that Teed is not properly combinable with the "primary" reference to Klasek in the manner proposed [\*9] by the examiner. Penman and Teed are essential to the examiner's case of obviousness. The examiner does not contend, nor do we find, that the combination of Klasek and Buell or the combined teachings of Klasek, Buell and Bourgeois are sufficient to establish the obviousness of appellants' claimed invention. Accordingly, the examiner's decision refusing to allow claims 10 through 18 and 21 is reversed.

REVERSED.